

**REMARKS**

**I. INTRODUCTION**

Claims 10, 14, 15, 18, 19, and 26 were previously canceled. Claims 2 and 12 are canceled herein above without prejudice, and new claims 27-30 have been added. Independent claims 1 and 11 have been amended to recite, *inter alia*, the step of applying at least one of heat or electromagnetic radiation to the predetermined area of skin so as to produce a plurality of thermally damaged regions of the tissue based on an interaction between the at least one chromophore and the electromagnetic radiation. Exemplary support for these amendments are found, *inter alia*, in paragraphs [0023] and [0033] of the originally-filed specification (U.S. Publication No. 2007/0264288, the “published application”). Exemplary support for new claim 27 can be found, *inter alia*, in paragraphs [0027] and [0030] of the published application. Further, exemplary support for new claims 28-30 can be found, *inter alia*, in paragraphs [0028] and [0033] of the published application.

Accordingly, claims 1, 3-9, 11, 13, 16, 17, 20-25 and 27-30 are now under consideration in the present application. Provided above, please find a claim listing indicating the current amendments to the previously-pending claims, cancellation of claims 2 and 12, addition of new claims 27-30, and status of other claims on separate sheets so as to comply with the requirements set forth in 37 C.F.R. § 1.121. It is respectfully submitted that no new matter has been added.

**II. INFORMATION DISCLOSURE STATEMENT**

In the Office Action, the Examiner indicated that copies of certain foreign documents and non-patent literature listed in the Information Disclosure Statement submitted on April 4, 2008 have not bee included therewith. Applicant was not aware that the U.S. Patent and Trademark Office did not receive copies of such documents. Thus, to expedite the prosecution of the present application, copies of these documents shall be provided for the present application to the Examiner in a separate communication.

Applicant respectfully requests that the Examiner consider such later-provided documents, initial SB/08A document which lists such documents, and provide the initialed SB/08A document to Applicant's representative in a subsequent communication.

**III. REJECTIONS UNDER 35 U.S.C. §§ 102 AND 103 SHOULD BE WITHDRAWN**

Claim 1 stands rejected under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Publication No. 2003/015965 by Anderson et al. (the "Anderson Publication"). (See Office Action, page 3). Claims 2-4 and 6-9 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over the Anderson Publication. (See *id.*, page 4). Claims 5, 11-13, 16, 17, 20-23, and 25 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over the Anderson Publication in view of U.S. Patent No. 5,836,998 issued to Mueller et al. (the "Mueller Patent"). (See *id.*, p. 8). Claim 24 stands rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over the Anderson Publication in view of U.S. Publication No. 2002/0091311 of Eppstein et

al. (the “Eppstein Publication”). (See *id.*, p. 7). Applicant respectfully asserts that the Anderson Publication, either taken alone or in combination with the Mueller Patent and/or the Eppstein Publication, fails to disclose, teach, or suggest the subject matter recited in amended independent claims 1 and 11 and the claims which depend from amended independent claim 1, for at least the reasons set forth below.

In order for a claim to be rejected as anticipated under 35 U.S.C. § 102, each and every element as set forth in the claim must be found, either expressly or inherently described, in a single prior art reference. Manual of Patent Examining Procedures, §2131; *also see Lindeman Machinenfabrik v. Am Hoist and Derrick*, 730 F.2d 1452, 1458 (Fed. Cir. 1984).

Under 35 U.S.C. § 103(a), a person is not entitled to a patent even though the invention is not identically disclosed or described as set forth in §102, “if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” 35 U.S.C. § 103(a).

The objective standard for determining obviousness under 35 U.S.C. § 103, as set forth in *Graham v. John Deere, Co.*, 383 U.S. 1 (1966), requires a factual determination to ascertain: (1) the scope and content of the prior art; (2) the level of ordinary skill in the art; and (3) the differences between the claimed subject matter and the prior art. Based on these factual inquiries, it must then be determined, as a matter of law, whether or not the claimed subject matter as a whole would have been obvious

to one of ordinary skill in the art at the time the alleged invention was made. *Graham*, 383 U.S. at 17. Courts have held that there must be some suggestion, motivation or teaching of the desirability of making the combination claimed by the applicant (the “TSM test”). See *In re Beattie*, 974 F.2d 1309, 1311-12 (Fed. Cir. 1992). This suggestion or motivation may be derived from the prior art itself, including references or disclosures that are known to be of special interest or importance in the field, or from the nature of the problem to be solved. *Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1573 (Fed. Cir. 1996).

Although the Supreme Court criticized the Federal Circuit’s application of the TSM test, see *KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741, (2007) the Court also indicated that the TSM test is not inconsistent with the *Graham* analysis recited in the *Graham v. John Deere* decision. *Id.*; see *In re Translogic Technology, Inc.*, No. 2006-1192, 2007 U.S. App. LEXIS 23969, \*21 (October 12, 2007). Further, the Court underscored that “it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.” *KSR*, 127 S. Ct. at 1741. Under the precedent established in *KSR*, however, the presence or absence of a teaching, suggestion, or motivation to make the claimed invention is merely one factor that may be weighed during the obviousness determination. *Id.* Accordingly, the TSM test should be applied from the perspective of a person of ordinary skill in the art and not the patentee, but that person is creative and not an automaton, constrained by a rigid framework. *Id.* at 1742.

However, "the reference[s] must be viewed without the benefit of hindsight afforded to the disclosure." *In re Paulsen*, 30 F.3d 1475, 1482 (Fed. Cir. 1994).

The prior art cited in an obviousness determination should create a reasonable expectation, but not an absolute prediction, of success in producing the claimed invention. *In re O'Farrell*, 853 F.2d. 894, 903-04 (Fed. Cir. 1988). Both the suggestion and the expectation of success must be in the prior art, not in applicant's disclosure. *Amgen, Inc. v. Chugai Pharmaceutical Co., Ltd.*, 927 F.2d 1200, 1207 (Fed. Cir. 1991) (citing *In re Dow Chem. Co.*, 837 F.2d 469, 473 (Fed. Cir. 1988)). Further, the implicit and inherent teachings of a prior art reference may be considered under a Section 103 analysis. See *In re Napier*, 55 F.3d 610, 613 (Fed. Cir. 1995).

Secondary considerations such as commercial success, long-felt but unsolved needs, failure of others, and unexpected results, if present, can also be considered. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1538-39 (Fed. Cir. 1983). Although these factors can be considered, they do not control the obviousness conclusion. *Newell Cos. v. Kenney Mfg. Co.*, 864 F.2d 757, 768 (Fed. Cir. 1988).

Independent claims 1 and 11 have been amended above to recite a method for fractional wounding of tissue that includes, *inter alia*, applying at least one chromophore to a predetermined area of skin, and **applying electromagnetic radiation to the predetermined area of skin so as to produce a plurality of thermally damaged regions of the tissue based on an interaction between the at least one chromophore and the electromagnetic radiation.**

The Anderson Publication relates to microparticles that can be used to form skin markings, such as tattoos, where such markings may be removed by application of energy, such as optical radiation. (See Anderson Publication, Abstract, and para. [0016]).

The Eppstein Publication describes methods and apparatus for increasing permeability of a biological membrane using a pyrotechnic charge to form openings therein. (See Eppstein Publication, Abstract, and paragraph [0041]). The methods and apparatus of Eppstein can be used with a substrate containing pigments, where the pigments are forced into the skin by the charge to form a tattoo. (*Id.*, para. [0044]).

The Mueller Patent describes the use of a stencil for body art whereby a stain is applied to a predetermined epidermal area delineated by the stencil. (See Mueller Patent, col. 1, line 65-col. 2, line 11).

Applicant respectfully asserts that the Anderson Publication does not teach, suggest or disclose any method in which ***a plurality of thermally damaged regions of tissue are produced based on an interaction between one or more chromophore(s) and an electromagnetic radiation***, as recited in amended independent claims 1 and 11. In contrast the Anderson Publication describes only a method for removing microparticles containing chromophores from skin tissue by applying electromagnetic radiation that ***does not damage the tissue*** (much less thermally damage the tissue), and which is “well tolerated” by the skin. (*Id.*, paras. [0150] and [0151]). Indeed, Applicant respectfully asserts that the Anderson Publication not only fails to disclose, teach or suggest the subject matter recited in amended

independent claims 1 and 1, this publication actually teaches away from such a method for fractionally wounding skin to generate thermal damage, and instead describes a method and substance for providing skin markings that can be removed by applying energy without damaging the surrounding tissue. [*Id.*, para. [0154]).

To establish obviousness, the prior art references must be evaluated as a whole for what they fairly teach and neither the references' general nor specific teachings may be ignored. *Application of Lundsford*, 357 F.2d. 385, 389-90 (CCPA 1966). The Examiner is respectfully reminded that a reference must be considered for all that it teaches, not just what purportedly points toward the invention but also that which teaches away from the invention. *Ashland Oil, Inc. v. Delta Resins & Refractories*, 776 F.2d. 281, 296 (Fed. Cir. 1985).

Thus, for at least the reasons provided herein above, Applicant respectfully asserts that the Anderson Publication fails to teach or suggest a method for fractional wounding that applies at least one chromophore and an electromagnetic radiation to a predetermined area of skin **so as to produce a plurality of thermally damaged regions of tissue based on an interaction between the chromophore and the electromagnetic radiation**, as recited in amended independent claims 1 and 11 of the present application. Applicant further asserts that the Anderson Publication actually teaches away from such subject matter that includes damaging of skin tissue. The Mueller Patent and the Eppstein Publication do not cure this deficiency, nor does the Examiner contend that they do.

Accordingly, Applicant respectfully asserts that the Anderson Publication, even if combined with the Mueller Patent and/or the Eppstein Publication, fails to anticipate or render obvious the subject matter recited in amended independent claims 1 and 11, and the claims that depend from independent claims 1 and 11, for at least the reasons provided above.

Thus, withdrawal of the rejections of these claims under 35 U.S.C. §§ 102(b) and 103(a) is respectfully requested.

**IV. CONCLUSION**

In light of the foregoing, Applicant respectfully submits that all arguments raised in the Office Action have been addressed and that all pending claims 1, 3-9, 11, 13, 16, 17, 20-25, and 27-30 are in condition for allowance. Prompt reconsideration and allowance of the present application are therefore earnestly solicited. The Examiner is invited to contact the undersigned to expedite the prosecution of this application if any issues remain outstanding.

Respectfully submitted,

Date: October 6, 2010

By: 

Gary Abelev  
Patent Office Reg. No. 40,479

DORSEY & WHITNEY, L.L.P.  
250 Park Avenue  
New York, New York 10177

Attorney(s) for Applicants  
(212) 415-9200